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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,546	02/07/2002	Subhash Chandra Taneja	82373	7828

7590 07/12/2004

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EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/067,546	<b>Applicant(s)</b> TANEJA ET AL.	
	<b>Examiner</b> Laura L. Stockton, Ph.D.	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 1-3 and 7-20 are pending in the application.

### *Election/Restrictions*

The entire scope of the elected product invention of Group I (claims 1, 2 and 20) has been examined.

Claims 3 and 7-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse (claims 7-19 only) in Paper No. 6 (April 30, 2003).

Rejections made in the previous Office Action that do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the instant specification or the originally filed claims can be found for R representing 2-propenyl as claimed in instant claim 1. Applicants did not show where support in the specification or the originally filed claims could be found {page number(s) and line number(s)} for R representing 2-propenyl. Applicants should specifically point out the support for any amendments. See M.P.E.P. §§ 714.02

and 2163.06. Further, enablement for a single compound cannot provide enablement for the breadth of claims sought in arts which are unpredictable. *Ex parte Hitzemann*, 9 USPQ2d 1821 (BPAI 1987).

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, compounds (i) and (v) lack antecedent basis from claim 1 since in claim 1, the R variable represents a C<sub>2</sub> to C<sub>5</sub> alkyl chain.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raman et al. {U.S. Pat. 6,346,539}.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim arylalkenoic acid heterocyclic amide compounds. Raman et al. teach arylalkenoic acid heterocyclic amide compounds that are structurally similar to the instant claimed compounds (column 3, lines 1-40; and the "alterations to nitrogen substituent" and "alterations to the phenyl substituent" in columns 5-6). See in Raman et al., for example, the compounds of formula (I) at the top of column 3 wherein n is zero; R<sup>2</sup> and R<sup>3</sup> together represent a carbon to carbon double bond; R<sup>1</sup> is an alkoxy group having from 1 to 3 carbon atoms; m is one and R<sup>6</sup>

represents a morpholino group (also see Applicants' compound vi in instant claim 2).

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the compounds in the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., treating skin conditions).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, skin conditions. The instant claimed

invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

### *Response to Arguments*

Applicants' arguments filed May 7, 2004 have been fully considered. Applicants argue that: (1) a genus of substituted aryl alkenoic acid heterocyclic amides having a utility as spicy and pungent food additives are claimed; (2) none of the cited references disclose a compound as presently claimed; (3) none of the cited references teach or suggest that compounds useful for treating skin conditions are also useful as spicy and pungent food additives; (4) a species or subgenus is always patentable, as a selection invention, over a previously disclosed genus which does not teach or suggest the particular species or sub-genus which is later claimed; and (5) no evidence has been offered that Applicants' selection and testing of the claimed compounds is in fact "indiscriminate".



All of Applicants' arguments have been considered but have not been found persuasive. Presently, only compounds are under examination in the instant application. There is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990).

Further, Raman et al. do direct one skilled in the art toward Applicants' specie found in instant claim 2. See in Raman et al. the compounds of formula (I) at the top of column 3 wherein n is zero, R<sup>2</sup> and R<sup>3</sup> together represent a carbon to carbon double bond; R<sup>1</sup> is an alkoxy group having from 1 to 3 carbon atoms; m is one and R<sup>6</sup> represents a morpholino group (also see Applicants' compound vi in instant claim 2). Further note the section titled "alterations to nitrogen substituent" and "alterations to the phenyl substituent" in columns 5-6 in Raman et al. Absent unexpected, unobvious and beneficial results of the instant claimed compounds over the compounds taught in Raman et

al., the instant claimed compounds would have been suggested to one skilled in the art and therefore, would have been obvious to one skilled in the art.

### *Conclusion*

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims 3 and 7-19 drawn to inventions nonelected without traverse in Paper No. 6 (April 30, 2003). A complete reply to the final rejection must include cancellation of nonelected claims (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

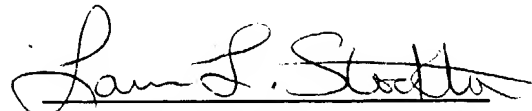
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in cursive script, reading "Laura L. Stockton".

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

July 8, 2004